

REMARKS

By this amendment, Applicant has amended the claims to further define the R group in claims 1 and 5. Support is found in the specification at, for example, pages 5-6 and the claims as originally filed. No new matter has been added. Applicant has also included with this amendment a declaration from Dr. Simon, an expert in the field, to support Applicant's assertion that the claims are not obvious upon reading CH Patent No. 629,258 ("Marka") and U.S. Patent No. 3,929,595 ("Biberbach") cited by the Examiner. Applicant respectfully requests reconsideration and allowance of this application.

Rejection Under 35 U.S.C. § 112, 1st Paragraph

The Examiner rejects claims 5-6 and 10-11 under 35 U.S.C. §112, first paragraph, because the Examiner alleges that the specification only enables electrodepositing glossy gold and gold alloy layers. Applicant respectfully traverses this rejection.

Applicant submits that the Examiner has not made a *prima facie* case that the claims are not enabled. However, to expedite prosecution of the present application, Applicant has amended claim 5 to include "electrodepositing" of glossy gold and gold alloy layers. This amendment does not add new matter. In light of this amendment, Applicant respectfully requests that the rejection under 35 U.S.C. §112, first paragraph be reconsidered and withdrawn.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

The Examiner rejects claim 10 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicant respectfully traverses this rejection.

Applicant submits that the claim is clear to one of ordinary skill in the art. Nevertheless, in order to expedite prosecution, Applicant has amended claim 5 to include electrodepositing of glossy gold and gold alloy layers. Accordingly, claim 10, which depends from claim 5, is definite and Applicant requests that the

rejections under 35 U.S.C. §112, second paragraph be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-11 under 35 U.S.C. §103(a) as being allegedly unpatentable over CH Patent No. 629,258 ("Marka") and U.S. Patent No. 3,929,595 ("Biberbach"). Applicant respectfully traverses this rejection.

To establish obviousness of a claimed invention, all claim elements must be taught or suggested by the prior art. Marka does not disclose an electrodeposition bath containing at least one specific gloss additive selected from the group consisting of pyridine-3-sulfonic acid, nicotinic acid, nicotinic acid amide, 3-(3-pyridyl)-acrylic acid, 3-(4-imidazolyl)-acrylic acid, 3-pyridylhydroxymethanesulfonic acid, pyridine, picoline, quinolinesulfonic acid, 3-aminopyridine, 2,3-diaminopyridine, 2,3-di-(2-pyridyl)-pyrazine, 2-(pyridyl)-4-ethanesulfonic acid, 1-(3-sulfopropyl)-pyridinium betaine, 1-(3-sulfopropyl)-isoquinolinium betaine and salts or derivatives thereof; in combination with an additional gloss additive that comprises sulfonate or sulfate of the general formula I. The Examiner concedes this point in the Office Action (page 6).

Further, Marka discloses that the gloss additive is an organic sulfonic or sulfinic surfactant. Sulfinic acid, sulfonic acid and sulfuric acid refer to groups having the following general formulas:

Sulfinic acid:	– SO ₂ H
Sulfonic acid:	– SO ₃ H
Sulfuric acid:	– SO ₄ H

Marka explicitly specifies, in the right column of page 2, lines 26 to 28, that only one gloss additive is used ("en plus, un additif brillanteur") and also in the examples only one gloss additive is used. Thus, there is no teaching in Marka to combine two gloss additives from two different groups as presently claimed, nor is there any indication of the beneficial effect from combining two of such gloss additives.

Biberbach discloses the addition of sulfonic acid derivatives to the gold baths -- particularly pyridine-3-sulfonic acid. However, Biberbach does not disclose, teach or suggest combining the sulfonate or sulfate of general formula I with the claimed specific gloss additives. Moreover, there is no teaching or suggestion to combine Marka with Biberbach. Applicant respectfully submits that the compounds of Biberbach fall under the generic definition of the gloss additives of Marka. Both, Biberbach and Marka disclose that through the addition of the gloss additive the deposition rate can be increased (Biberbach: col. 2, line 6; Marka: left column on page 3, line 30 "permet de remédier les suivants: vitesse de déposition faible").

It is respectfully submitted that it is not just a matter of combining any two gloss additives in an electrodeposition bath expecting improved gloss as asserted by the Examiner (Office Action, Page 11). Upon reading Marka and Biberbach the skilled artisan will realize that these references disclose essentially the same group of compounds. One of ordinary skill in the art might contemplate substituting the specific gloss additives of Marka with the gloss additive of Biberbach. But there is no teaching or suggestion at all in both disclosures to combine the additive of Biberbach with a specific additive of Marka -- which one is it suggested to combine?

Filed with this amendment is the Declaration from Dr. Simon, one skilled in the art, discussing that the results obtained from the combination of the specific gloss additive with the sulfonate or sulfate gloss additives of general formula I were unexpected because the bath achieves unexpectedly improved current density/working range and deposition rate. Further, Dr. Simon's declaration shows that the combination of certain gloss additives are actually detrimental to the electrodeposition process and that the claimed combination would not be obvious to one of ordinary skill in the art upon reading Marka and Biberbach. Thus, it is not just a matter of combining any two gloss additives in an electrodeposition bath expecting improved gloss as asserted by the Examiner.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

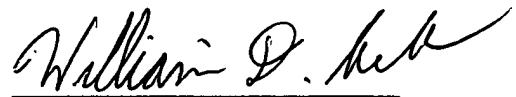
Conclusion

All of the stated grounds of the rejections have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that the present application is in condition for Allowance. Entry of amendment, and reconsideration of the application is respectfully requested.

If any additional fees are due, or an overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

If a telephone conference would be of assistance in furthering the prosecution of the application, Applicants' undersigned attorney requests that she be contacted at the telephone number provided below.

Respectfully submitted,

A handwritten signature in cursive script, reading "William D. Schmidt", written in black ink over a horizontal line.

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